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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,493	07/08/2003	Nancy Rapp	118443-1005	8973

32914 7590 06/29/2006  
GARDERE WYNNE SEWELL LLP  
INTELLECTUAL PROPERTY SECTION  
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EXAMINER

LARSON, LOWELL A

ART UNIT PAPER NUMBER

3725

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

88

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/615,493	RAPP ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Lowell A. Larson	3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 37 to 75 is/are pending in the application.
- 4a) Of the above claim(s) 60, 61 and 63 to 75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37 to 59 and 62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 22, 2006 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Election/Restrictions***

3. Claims 60, 61 and 63 to 75, drawn to a channel letter coil, are grouped with the non-elected invention of Group II in the restriction requirement of December 13, 2004 and, therefore, withdrawn from further consideration in this application. The restriction requirement was made final for the reasons set forth in the Office action of March 31, 2005.

Applicant's remarks in the response filed May 22, 2006 regarding the restriction requirement have been considered but are not persuasive. In particular, the remarks pertain to distinctness between non-elected Groups I and II of the December 13, 2004 restriction requirement, and are, therefore, considered to be moot regarding the distinctness of the elected invention (Group III of the December 13, 2004 restriction requirement).

The restriction requirement continues to be in Final status for the reasons set forth in the March 31, 2005 Office action.

***Claim Rejections - 35 USC § 112***

4. Claims 37 to 59 and 62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. These claims require the channel letter coil to have a reflectivity of above 90%. Such reflectivity is mentioned in passing at the top of page 5 of the specification, followed by a catalog of optional coating materials, number of coating layers and application methods. No disclosure is found of whether such degree of reflectivity is due to use of a specific combination of coating materials, or by a particular method of application, or if each combination of coating materials disclosed produces the 90% reflectivity, or if other particular techniques are necessary to obtain particular degrees of reflectivity. Thus, one skill in the art is not enabled to practice the invention as claimed without an undue amount of experimentation. It is noted that the specification itself must disclose how to practice the invention, and not direct others to find out for themselves.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 37 to 59 and 62 are further rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims purport to be a method of producing a channel letter coil, and include rolling a coated substrate into a coil. The claims now further recite forming the coil into shapes of individual characters to thereby provide a finished channel letter coil. However, it appears that the finished channel letter coil would be obtained when the substrate is rolled into a coil, and that the individual character shapes could only be formed by unrolling the coil and separating individual character blanks from the substrate. Thus, the scope of the claim is uncertain as to whether forming individual character articles is required or whether only forming a coil is required. Therefore, one skilled in the art would be unable to determine exactly when infringement might occur.

***Claim Rejections - 35 USC § 103***

7. Claims 37 to 59 and 62 are, alternatively, rejected under 35 U.S.C. 103(a) as being unpatentable over Benefiel in view of Maze et al. (of record).

Benefiel applies in the manner set forth in the last Office action (paper mailed January 20, 2006). In addition, Benefiel discloses pigmented thermo-setting polyester to be a suitable coating material for obtaining a high-gloss finish, as now specified by Claims 37 and 41 (column 6, lines 60 to 65), and that the opposite side of the substrate may also be provided with a pigmented coating, as now required by the claims (column 4, lines 33 to 35, and column 6, lines 40 to 55). As set forth in the last Office action, one skilled in the art is expected to have the ability to select materials to produce desired

characteristics in the coated substrate. Thus, the recitation in these claims that the coated product has a reflectivity above 90% is not considered to be a patentable distinction absent a disclosure of criticality in the use of specific techniques or combinations of materials to produce a particular reflectivity.

Official notice is taken that disposing first and second coating materials in a single step, as required by Claim 56, is a well known expedient in the coating art, and to apply the coating material of Benefiel in such a manner would be merely an obvious utilization of conventional knowledge present in the art.

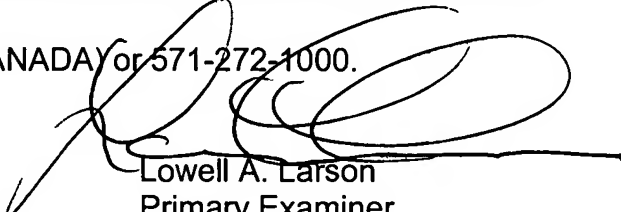
Applicant's remarks in the response filed May 22, 2006 have been carefully considered but are not found to be persuasive. In particular Applicant asserts that Benefiel is not in the same field of endeavor as the invention. However, Maze et al. shows that those skilled in the art consider teachings regarding coated substrates to be ecumenical to the formation of products for various uses. See column 7, lines 45 to 57. Thus, one skilled in the art would consider a teaching of coating processes for providing coils of high-gloss stock material for the automotive industry, such as Benefiel, to be reasonably pertinent to finding solutions for the provision of high-gloss stock material to manufacturers regardless of any specific product intended to be fabricated absent a disclosure of a specific nexus between any particular coating process and fabricated product.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lowell A. Larson whose telephone number is (571) 272-4519. The examiner can normally be reached from M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Banks Derris can be reached at (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Lowell A. Larson  
Primary Examiner  
Art Unit 3725

LAL  
June 23, 2006